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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,393	08/21/2001	Mototsugu Abe	09792909-5139	8089
26263	7590	03/24/2005	EXAMINER	
SONNENSCHN NATH & ROSENTHAL LLP			DANG, THANH HA T	
P.O. BOX 061080			ART UNIT	
WACKER DRIVE STATION, SEARS TOWER			PAPER NUMBER	
CHICAGO, IL 60606-1080			2163	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Handwritten: H

Office Action Summary

Application No.

09/934,393

Applicant(s)

ABE ET AL.

Examiner

Thanh-Ha Dang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-10 are rejected in this Office Action.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 8 recites an information processing method, which is an abstract idea, without need for physical computing equipment, and therefore constitutes non-statutory subject matter. The abstract idea comprising the steps of storing, calculating, deleting, presenting, and calculating, is not instantiated into some specific physical implementation. The claim language raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C.101.

Claim 9 recites a storage medium for storing a computer readable program, which is functional descriptive material, and therefore constitutes non-statutory subject matter. The claim describes the "program code for a step of ..." as an abstract idea in that the "program code for a step of ..." claimed can be

implemented using pencil and paper, without need for physical computing equipment. The storage medium, in broader claim, can be read as paper carrying hand-written program code.

Examiner suggests the use of "a computer-readable medium storing" in place of "a storage medium for storing" in order to make the claim describes statutory subject matter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "the other apparatus" in two different paragraphs: "calculating ...", and "presenting..." There is lack of antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,618,727 issued to Wheeler et al. ("Wheeler").

As to claim 1, Wheeler teaches "an information processing apparatus comprising:

- storage means for storing a candidate list in which contents are registered" (Figure 1, wherein block22 illustrates a storage means, column 8, lines 6-8);

- “calculation means for calculating the degrees of similarity of the contents registered in the candidate list according to search conditions input from the other apparatus” (Figures 6 (block21), 7 (block36 and block37), and 9; column 9, lines 65-67, column 10, lines 1-18 and lines 25-49; Figures 18A-B, 19 and 20 illustrate the similarity scoring process);
- “deleting means for deleting a content from the candidate list when it is determined that the degree of similarity of the content calculated by the calculation means is smaller than a predetermined threshold” (Figures 15A-B, wherein block120, block133 and block 135 illustrates the deleting means, column 13, lines 59-67 and column 14, lines 1-11); and
- “presentation means for presenting a question to the other apparatus when the total number of contents remaining in the candidate list as a result of the deletion by the deleting means is equal to or larger than a predetermined number” (Figures 10, 11 and 16, column 10, lines 59-65, column 12, lines 57-67, column 13, lines 1-17 and column 14, lines 12-38),
- “wherein when the question is presented, the calculation means further calculates the degrees of similarity of the contents registered in the candidate list according to search conditions additionally input from the other apparatus” (Figures 18A-B, 19, 20, 21A-F and 22, column 14, lines 52-67, column 15, lines 1-67, column 16, lines 1-67, column 17, lines 1-67, column 18, lines 1-67 and column 19, lines 1-11).

As to claim 2, Wheeler teaches “transmitter means for transmitting the candidate list to the other apparatus when the total number of contents remaining in the candidate list as a result of the deletion by the deleting means is smaller than the predetermined number” (Figures 1 and 5, wherein block14 and block20 serves as transmitter means, column 7, lines 64-67, column 8, lines 1-12 and column 9, lines 30-37), and delivery means for delivering the content to the other apparatus when a request to supply the content registered in the candidate list transmitted from the transmitter means is received from the other apparatus” (Figures 1 and 5, wherein block14 and block20 serves as delivery means, column 7, lines 64-67, column 8, lines 1-12 and column 9, lines 30-37).

As to claim 3, Wheeler teaches:

- “acquisition means for acquiring user information from the other apparatus” (Figures 2, 3, and 4A display the acquisition means via graphical user interface, column 8, lines 24-67, column 9, lines 1-37; Figures 1 (block16, block17, and block25) and 5 (block15, block16, and block17), column 8, lines 13-17); and
- “authentication means for authenticating the user information acquired by the acquisition means” (Figures 1 and 5, wherein authenticating the user information is equivalent to user administration (block16), column 8, lines 13-17),

- “wherein the delivery means delivers the content based on the authentication result provided by the authentication means” (Figures 1 and 5, wherein authenticating the user information is equivalent to user administration (block16), column 8, lines 13-17; and Figures 1 and 5, wherein block14 and block20 serves as delivery means, column 7, lines 64-67, column 8, lines 1-12 and column 9, lines 30-37).

As to claim 4, Wheeler teaches “recording means for recording, in the candidate list, the degree of similarity calculated by the calculation means, and a position having a similarity in the content” (Figure 4A illustrates a processing apparatus which includes the degree of similarity, column 9, lines 8-12; Figure 5 (block20), column 8, lines 6-8).

As to claim 5, Wheeler teaches “the content contains one of video data and music data” (Figure 11 (block77), wherein sound coding is equivalent and related to music and video data, column 11, lines 30-50).

As to claim 6, Wheeler teaches “a format of the search condition contains a text, a text relating to music, a video program, a voice, a singing voice, humming, or music” (column 11, lines 30-50).

As to claim 7, Wheeler teaches “the search condition includes, in whole or in part, a title of music, a name of a player, a name of a composer, a name of a lyric writer, a name of a conductor, a genre of the music, lyric, the music, performance by humming or singing voice, information relating to the music, speech, a name of an actor, a video program, reproduction of the video program,

and information relating to the video program (Figures 9, 10, and 11 (block77), column 11, lines 30-50).

Claim 8 is essentially the same as Claim 1 except that the claim sets forth the claimed invention as a method rather than an apparatus and therefore is rejected for the same reason as applied hereinabove.

As to claim 8, Wheeler teaches "an information processing method comprising the steps of:

- storing a candidate list in which contents are registered" (Figure 1, wherein block22 illustrates a storage means, column 8, lines 6-8);
- "calculating the degrees of similarity of the contents registered in the candidate list according to search conditions input from the other apparatus" (Figures 6 (block21), 7 (block36 and block37), and 9; column 9, lines 65-67, column 10, lines 1-18 and lines 25-49; Figures 18A-B, 19 and 20 illustrate the similarity scoring process);
- "deleting a content from the candidate list when it is determined that the degree of similarity of the content calculated in the calculation step is smaller than a predetermined threshold" (Figures 15A-B, wherein block120, block133 and block 135 illustrates the deleting means, column 13, lines 59-67 and column 14, lines 1-11); and

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- “presenting a question to the other apparatus when the total number of contents remaining in the candidate list as a result of the deletion in the deleting step is equal to or larger than a predetermined number” (Figures 10, 11 and 16, column 10, lines 59-65, column 12, lines 57-67, column 13, lines 1-17 and column 14, lines 12-38),
- “wherein when the question is presented, the calculation step further calculates the degrees of similarity of the contents registered in the candidate list according to search conditions additionally input from the other apparatus” (Figures 18A-B, 19, 20, 21A-F and 22, column 14, lines 52-67, column 15, lines 1-67, column 16, lines 1-67, column 17, lines 1-67, column 18, lines 1-67 and column 19, lines 1-11).

Claim 9 is essentially the same as Claim 8 except that the claim sets forth the claimed invention as an apparatus rather than a method and therefore is rejected for the same reason as applied hereinabove.

As to claim 9, Wheeler teaches “a storage medium for storing a computer readable program, the program comprising:

- a program code for a step of storing a candidate list in which contents are registered” (Figure 1, wherein block 22 illustrates a storage means, column 8, lines 6-8);

- “a program code for a step of calculating the degrees of similarity of the contents registered in the candidate list according to search conditions input from the other apparatus” (Figures 6 (block21), 7 (block36 and block37), and 9; column 9, lines 65-67, column 10, lines 1-18 and lines 25-49; Figures 18A-B, 19 and 20 illustrate the similarity scoring process);
- “a program code for a step of deleting a content from the candidate list when it is determined that the degree of similarity of the content calculated in the calculation step is smaller than a predetermined threshold” (Figures 15A-B, wherein block120, block133 and block 135 illustrates the deleting means, column 13, lines 59-67 and column 14, lines 1-11); and
- “a program code for a step of presenting a question to the other apparatus when the total number of contents remaining in the candidate list as a result of the deletion in the deleting step is equal to or larger than a predetermined number” (Figures 10, 11 and 16, column 10, lines 59-65, column 12, lines 57-67, column 13, lines 1-17 and column 14, lines 12-38),
- “wherein when the question is presented, the calculation step further calculates the degrees of similarity of the contents registered in the candidate list according to search conditions additionally input from the other apparatus” (Figures 18A-B, 19, 20, 21A-F and 22, column 14, lines 52-67, column 15, lines 1-67, column 16, lines 1-67, column 17, lines 1-67, column 18, lines 1-67 and column 19, lines 1-11).

As to claim 10, Wheeler teaches “an information processing system comprising a first information processing apparatus and a second information processing apparatus, wherein the first information processing apparatus comprises:

- storage means for storing a candidate list in which contents are registered” (Figure 1, wherein block22 illustrates a storage means, column 8, lines 6-8);
- “calculation means for calculating the degrees of similarity of the contents registered in the candidate list according to search conditions input from the second information processing apparatus” (Figures 6 (block21), 7 (block36 and block37), and 9; column 9, lines 65-67, column 10, lines 1-18 and lines 25-49; Figures 18A-B, 19 and 20 illustrate the similarity scoring process);
- “deleting means for deleting a content from the candidate list when it is determined that the degree of similarity of the content calculated by the calculation means is smaller than a predetermined threshold” (Figures 15A-B, wherein block120, block133 and block 135 illustrates the deleting means, column 13, lines 59-67 and column 14, lines 1-11); and

- “presentation means for presenting a question to the second information processing apparatus when the total number of contents remaining in the candidate list as a result of the deletion by the deleting means is equal to or larger than a predetermined number” (Figures 10, 11 and 16, column 10, lines 59-65, column 12, lines 57-67, column 13, lines 1-17 and column 14, lines 12-38); and
- “the second information processing apparatus comprises:
 - first transmitter means for transmitting, to the first information processing apparatus, the search conditions for searching the contents” (Figure 1, wherein system 10 displays the first transmitter which includes block11, block14, block15, and block20, column 7, lines 64-67, column 8, lines 1-12);
 - “receiver means for receiving the question presented by the first information processing apparatus” (Figure 1, wherein block14 and block20 function as a receiver means, column 7, lines 64-67, column 8, lines 1-12); and
 - “second transmitter means for transmitting, to the first information processing apparatus, an additional search condition when answering the question received from the receiver means” (Figure 1, wherein system10 displays the second transmitter means (block12), column 7, lines 64-67, column 8, lines 1-12 and column 9, lines 24-37).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh-Ha Dang whose telephone number is 571-272-4033. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thanh-Ha Dang
Examiner
Art Unit 2163



ALFORD KINDRED
PRIMARY EXAMINER